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# Supreme Court of the United States

October Term 1941

No. 953

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ARCADIA KNITTING MILLS, INC.,
*Respondent,*

vs.

PRINCETON KNITTING MILLS, INC.,
*Petitioner.*

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## RESPONDENT'S ANSWER TO PETITION FOR WRIT OF CERTIORARI, AND SUPPORTING BRIEF

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## RESPONDENT ARCADIA'S ANSWER TO PETITION FOR WRIT OF CERTIORARI

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This is an ordinary patent suit, adjudicated only in the Second Circuit. There has been no adjudication of the patent, No. 2,123,847, in any other circuit and so far as we are aware, no suit on this patent is pending in any other circuit. No unusual questions are involved. In fact, no question is involved except that arising from petitioner Princeton's refusal to accept the decision of the District Court, and the unanimous affirming decision of the Court of Appeals, that the patent, covering a simple construction of a cloth, is anticipated by cloths of the *same* construction made by respondent and another company prior to peti-

tioner's earliest date. The Courts below had the witnesses before them, the exhibits before them, and all the arguments of petitioner that the proofs of prior user were insufficient to anticipate. The Courts below rejected petitioner's contention and found that anticipation existed *beyond a reasonable doubt.* On this point the District Court held that anticipation existed not only because of prior use and sale of cloth 1838, on which Princeton founds its petition, but also because of prior use and sale of other cloths on which Princeton is silent:—two additional prior cloths of Arcadia, Nos. 2362 and 2294a and a prior cloth of Elkind Knitting Mills, Inc., exhibit 54. The Court of Appeals in effect held that anticipation was completely established by cloth 1838. The pertinent passages from the opinions sum up the issue:—

The District Court held (Rec. p. 422, 39 F. Supp. 156):—

> "Claims 2 and 4 of the patent are invalid because anticipated by prior knowledge and use. I am convinced *beyond any reasonable doubt* that Arcadia produced and sold in 1936 and 1937 to some sixteen manufacturers approximately 35,000 yards of cloth, known as 'Arcadia 1838', and small amounts of two other fabrics referred to as 'Arcadia 2294a' and 'Arcadia 2362' respectively, all of which had the *exact* arrangements of floats and inlays of claims 2 and 4, and another manufacturer, the Elkind Knitting Company, produced and sold a similar fabric during 1932 and 1934." (Italics ours.)
>
> "The validity of claims 1 and 3 depends upon whether or not making the floats and inlays one needle wide instead of two or more needles wide involves invention, the arrangements of floats and inlays being alike." * * *

> "The making of a fabric with an old arrangement of floats and inlays only one needle wide, instead of two or three needles wide, does not seem to me to amount to invention in view of the highly developed state of the art of knitting. To permit Princeton to have a monopoly on the ground that it or the patentee had discovered or invented something new would, I think, be depriving the public of knitting practices it had been using for years."

The Court of Appeals affirmed the finding that broad claims 2 and 4 were anticipated and held with respect to narrower claims 1 and 3, for which petitioner asks special consideration (Rec. p. 442, 124 F. (2d) 330):

> "There is no reason to support that any popularity which the fabric enjoyed depended upon the successions of claims 1 and 3; that is, that they made a more acceptable fabric than that which claim 2 added. The specifications do not suggest any superiority of one over the other; and it is plain that all are open to any one's choice, provided that the "one and one arrangement" itself is open. Certainly after *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. ——, 62 S. Ct. 37, 86 L. Ed. ——, we should not be warranted in hanging a patent upon so slender a thread."

The record does not support petitioner's assertions that any important Federal or other question is involved justifying a review by this Court.

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# BRIEF

## Statement

The petition mistakenly asserts that serious questions of law are involved when, in fact, the only questions are (1) Whether certain cloths made by respondent anticipated the broad claims of petitioner's patent and (2) whether the narrow claims are patentable if the broad ones are anticipated.

The Circuit Court of Appeals affirmed the decision of the District Court that the proofs established manufacture and sale by respondent of thousands of yards of cloth prior to petitioner's earliest date, and that the structure of this cloth anticipated claims 2 and 4. Claims 1 and 3 differ from claims 2 and 4 in that they specify the use of *floats* three in one row then three in the next row instead of staggered every other row. The use of *floats* three in a row but somewhat wider than the *floats* petitioner says its claims cover was admitted by petitioner to be open to public use (Rec. p. 124). The Courts below held that in either event claims 1 and 3 were invalid as representing insignificant changes in arrangements of *floats* over invalid claims 2 and 4 covering staggered *floats,* or over the prior precise arrangement of *floats* which were of greater width.

## Brief History

Petitioner Princeton owns Fleisher Patent 2,123,847 issued July 12, 1938, filed February 23, 1938, covering the structure of a cloth. Princeton threatened to sue, for alleged infringement of said patent, various manufacturers and their customers using certain cloth and selling

garments made of said cloth supplied by respondent Arcadia. Princeton failed to sue whereupon Arcadia filed suit under the Declaratory Judgments Act (Title 28, U. S. Code, Sec. 400) in order to stop Princeton's campaign of intimidation against Arcadia's customers and those who bought from them, such as department stores.

The whole issue in the litigation below resolved itself into a question of fact, and no question of law is involved other than the usual well established principles governing anticipation.

## Contentions of Petitioner Not Supported by Record

This patent is of no special concern to the public but even if it were, there is no conflict between different circuits, no confusion because of legal unsettlement, and certainly no significant public interest involved requiring the grant of Princeton's petition.

Princeton is seeking to convert the questions of fact on which the Courts below concluded that the claims were anticipated into a non-existent question of law, relating to acceptance of proofs. The proofs in this case consisted of testimony of witnesses in open court, supported by records, book entries, and physical specimens of the prior uses, all of which Princeton was given complete opportunity to investigate. The Courts found as a matter of fact that these proofs established manufacture and sale of that which the claims covered prior to Princeton's earliest date. This is the sole question involved, and Princeton's attempt to turn this into a new question of law merely places a burden upon this Court, as well as upon respondent, not contemplated under accepted practice.

## The Invention

As was described correctly in the decision of the District Court (Rec. p. 420)

> "The Fleischer patent was issued for a fabric, much similar to all knitted fabrics of this 'inlaid' type, which consists of two parts knitted together, (1) a plain jersey cloth base on which (2) yarn is laid in the form of floats and inlays. A 'float' is a loose piece of yarn laid upon the base fabric, and an 'inlay' is simply a continuation of the float which is interwoven with the base fabric and this upper side of the fabric may be brushed, if suitable yarns are used, to give it a fluffy appearance."

As was aptly pointed out by the trial court:

> * * * "*the claims are restricted to precise groupings or arrangements of floats and inlays on the basic knitted fabric.*"
>
> "The difference between the broad claims 2 and 4 and claims 1 and 3 is that in claims 2 and 4 the floats are staggered over two rows, whereas in claim 1 the floats must be three in a row and at least two in a row in claim 3" (Rec. p. 421, italics ours).

Shown in the opinion of the District Court (Rec. p. 420) is Exhibit 56, photo of a blackboard diagram used at the trial to indicate the arrangement of floats constituting the sole subject matter of the claims. In claims 2 and 4 the floats or laid on yarns are arranged in alternate rows, as shown in grouping (2) of the diagram, whereas claims 1 and 3 specify such use of floats three in one row and then three in the adjacent row, as shown in grouping (1) of the diagram.

## The Prior Uses

While the prior art shows much use of floats and inlays in a wide variety of cloths, Arcadia primarily relied upon prior uses comprising cloths made by it and by Elkind Knitting Mills, Inc., prior to Princeton's earliest date of February 23, 1938. These prior uses were selected because the structures of these old cloths made by Arcadia and Elkind included the exact float groupings of each of the claims. While the different cloths employing these precise float groupings were made of yarn different in feel and appearance from the yarns used by Princeton, the float structures or groupings were precisely the same. The claims are not restricted to any particular type of yarns but are confined to *precise* float groupings without regard to type or appearance of yarns, which are matters of selection anyway, depending on the use to which different cloths are to be put.

## Arcadia Cloths 1838, 2362, 2294a, and Elkind Cloth Exhibit 54 Anticipate Claims 2 and 4

In 1935 and 1936 Arcadia made and sold quantities of its cloths 1838, 2362 and 2294a and these cloths had the exact float grouping of claims 2 and 4 (Exhibits 64e, f, g, 80-82).

Prior to Arcadia's manufacture of these cloths, Elkind had made its cloth, Exhibit 54, which also had the exact float grouping of claims 2 and 4 (Rec. p. 31-34, 48, 49).

The cloths were produced in Court. The people who made the cloths were produced in Court and testified that these cloths had been made by them prior to Princeton's earliest date and had the exact float groupings of the claims. The men who set up the machines for making the respective cloths were produced in Court, identified the

cloths, testified when their manufacture took place, described the float groupings, and showed they were precisely as covered by the claims. In the case of all of Arcadia's cloths, invoices, book entries, and accounting records were produced tracing sales, delivery and payment of each of these cloths prior to Princeton's earliest date (Exhibits 80-82). Record folders showing when the cloths were first made up and authorized for production were produced in Court and Princeton was given four weeks in which to investigate the sales made by Arcadia to check whether the cloths as represented had actually been sold and paid for (Exhibits 64b-g, Rec. p. 303). Not a word is in the record nor was any attempt made by Princeton in any way to impeach the authenticity of these sales; and the facts are conclusive that the exhibits of record show the exact cloths which were made and sold prior to Princeton's earliest date and which completely anticipate the claims (Exhibits 64, e, f, g, c, d, 51, 52, 54).

Princeton is grasping at a straw in attacking a folder, Exhibit 64g, of cloth 1838, because this folder contains the words "new setup" and several invoices showed sales of cloth 1838, prior to the date on the folder. However, the testimony is clear that the folders were made up in the shop, as opportunity presented itself, *after* the cloths had been authorized for production, and the testimony is conclusive that Arcadia had only one cloth with the number 1838 and that this is the cloth which was sold to some sixteen manufacturers in an amount approximately 35,000 yards (Rec. p. 81, 95, 104, 391, 386-90). Some of this cloth was sold to customers of Princeton, and Princeton's investigations surely would have disclosed differences in structure, assuming such differences existed. Similarly, Princeton produced witness Sussman whose company had bought thousands of yards of this cloth and if the structure had

not been exactly as represented, this could easily have been brought out (Ex. 81, 82).

### Claims 1 and 3 Similarly Anticipated

Arcadia cloths 2386 and 2387 used the precise arrangement of floats and inlays specified in claims 1 and 3, except the floats were three needles wide as illustrated in group (4) on the diagram (Rec. p. 420). Elkind cloths, Exhibits 51 and 52 also had the precise arrangement of floats and inlays specified in claims 1 and 3, except the floats and inlays were two needles wide, illustrated in group (3) on the diagram. The date of manufacture of these cloths was proved to the same degree as in the case of the cloths anticipating claims 2 and 4. Specimens of the cloths were produced. The people who made them were produced. (Exhibits 51, 52, 64c, d.)

Princeton admitted in open Court that the public has the right to make fabrics with the same arrangements of floats and inlays as shown in groups 3 and 4 of the diagram, with floats and inlays two and three needles wide (Rec. p. 124); but contends that claims 1 and 3 are confined to floats and inlays one needle wide, and bases its claim to a monopoly on this trivial difference.

The Courts below properly held that the difference between such an old arrangement with floats two or three needles wide, which the public has the right to use, and floats one needle wide, to which Princeton claims a monopoly, is too insignificant a difference on which to predicate invention. The District Court correctly pointed out that the Wildman knitting machine on which all of these cloths are made can very easily be adjusted to make floats, one

needle wide, two needles wide, or any other width. The law on this point is clearly laid down in the recent decision of this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. ——, 62 S. Ct. 37, 86 L. Ed. ——, citing *Atlantic Works v. Brady*, 17 Otto 192, 200.

## CONCLUSION

We submit that there is no merit in the petition and that it should be denied.

Respectfully submitted.

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Syracuse, N. Y., March 7, 1942.